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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,065	11/12/2003	Michael Sittinger	27600/X014A	6362
29471	7590	07/14/2006	EXAMINER	
MCCRACKEN & FRANK LLP 200 W. ADAMS STREET SUITE 2150 CHICAGO, IL 60606			MACKEY, PATRICK HEWEY	
			ART UNIT	PAPER NUMBER
			3651	

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/706,065

Applicant(s)

SITTINGER ET AL.

Examiner

Patrick H. Mackey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>051506</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/15/2006 has been entered.

### ***Requirement of Information Under 37 C.F.R. § 105***

2. The applicant and/or the assignee of this application are required under 37 C.F.R. § 105 to provide the examiner with the following information the examiner has determined is reasonably necessary for the examination of this application.

3. Please respond to the following interrogatory:

What structure from the disclosure corresponds to the limitation invoking 35 U.S.C. 112 6<sup>th</sup> paragraph "means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page" found in claim 23?

4. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite that the printer prints customized content on at least a portion of at least one of the pages “without limitation as to position and orientation of the customized content over an entire surface of the at least one page”. There is no support for this limitation in the specification as originally filed.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 53 and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are method claims which depend from apparatus claims.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 2, 8, 9, 13, 23, 24, 30, 31, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Dooley (US 6,257,566). Dooley discloses a book production device that includes

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a gathering line (14); a demand printer (56); a feeding device (58); a packer box (16) with a transfer mechanism (see col. 4, line 3); and a controller (60).

11. Claims 1, 2, 12-16, 20, 22-24, 35-38, 43-45, and 49-51 are rejected under 35

U.S.C. 102(b) as being anticipated by Graushar (US 5,100,116). Graushar discloses a book production device that includes a gathering line (18); a plurality of demand printers (32, see col. 4, line 51); a feeding device (33); and a controller (31).

12. Claims 1, 2, 6, 7, 12-18, 20, 22-24, 28-29, 35-38, 41 and 43-54 are rejected under 35

U.S.C. 102(b) as being anticipated by Weller (US 4,989,850). Weller discloses a book production apparatus that includes a gathering line (90); a plurality of demand printers (75, see col. 5, lines 1-6); a feeding device (GR); a folding device (see col. 4, line 56); and a controller (see col. 3, line 56).

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 3-5, 25-27, and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graushar in view of Warmus et al. (US 5,963,968). Graushar discloses all the limitations of the claims, but it does not disclose utilizing a template file having fixed and variable information separated into data streams and provided to a collator/raster image processor together with a database and a press command file. However, Warmus discloses a book production device that includes disclose utilizing a template file having fixed and variable information separated into

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data streams and provided to a collator/raster image processor together with a database and a press command file for the purpose of producing differing book versions in an efficient manner (see col. 3, lines 8-10). It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Graushar by utilizing a template file having fixed and variable information separated into data streams and provided to a collator/raster image processor together with a database and a press command file, as disclosed by Warmus, for the purpose of producing differing book versions in an efficient manner.

15. Claims 10-11, 14, 17, 19, 32, 33, and 34 rejected under 35 U.S.C. 103(a) as being unpatentable over Dooley in view of Weller. Dooley discloses all the limitations of the claims, but it does not disclose a folder and it does not disclose a plurality of demand printers. However, Weller discloses a book production device that includes a folder for the purpose of processing signatures which have not been folded (see col. 3, lines 4-6) and Weller discloses utilizing a plurality of demand printers for the purpose of customizing more than one page. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Dooley by utilizing a folder and a plurality of demand printers, as disclosed by Weller, for the purpose of processing signatures which have not been folded and customizing more than one page.

16. Claims 14, 21, 36 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dooley in view of Graushar. Dooley discloses all the limitations of the claims, but it does not disclose a plurality of demand printers. However, Graushar discloses a book production device that includes a plurality of demand printers for the purpose of customizing more than one page. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's

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invention to modify Dooley by utilizing a plurality of demand printers, as disclosed by Graushar, for the purpose of customizing more than one page.

***Response to Arguments***

17. Applicant's arguments filed 5/15/06 have been fully considered but they are not persuasive.

18. The applicant states that none of the art cited by the examiner discloses or suggests book production apparatus including a demand printer operable during a single production sequence to produce different printed pages in response to print commands issued during a single continuous production sequence, wherein the demand printer prints customized content on at least a portion of at least one of the pages without limitation as to position and orientation of the customized content over an entire surface of the at least one page together with a controller that coordinates simultaneous issuance of the print commands to the demand printer and operation of a gathering line, the demand printer, and a feeding device during the single production sequence, as recited by claims 1-22. In response, the examiner notes that the claims do not recite any structure not found in the prior art. Nor do the claims or the specification limit the definition of a "single production sequence".

19. The applicant states that none of the prior art cited by the examiner discloses or suggests book production apparatus including a demand printer for producing first and second different pages each having customized content that is disposed in an orientation at a position on a surface thereof, wherein the first and second pages are printed during a time interval during which a gathering line is continuously moving and wherein the demand printer includes means for printing the customized content on at least a portion of each page without limitation as to the

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orientation and position of the customized content over an entire surface of the page together with a controller that coordinates operation of the gathering line, the demand printer, and a feeding device during a production sequence to produce customized books, as recited by claims 23-35 and 43-48. In response, the examiner notes that the claims do not recite any structure not found in the prior art.

### ***Conclusion***

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick H. Mackey whose telephone number is (571) 272-6916. The examiner can normally be reached on Tuesday-Friday 7:00 a.m. - 5:30 p.m..



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Patrick H. Mackey  
Primary Examiner  
Art Unit 3651

July 7, 2006